

10 GOOGLE LLC,

11 Plaintiff,

No. C 20-06754 WHA

12 v.

13 SONOS, INC.,

14 Defendant.

**ORDER DENYING LEAVE TO FILE
SUPPLEMENTAL CLAIM
CONSTRUCTION BRIEFING**

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18 Google has filed a motion for leave to file supplemental claim construction briefing (Dkt.
19 No. 375). The basis for its motion is its recent discovery of statements made by Sonos's
20 Australian counsel during the foreign prosecution of an "Australian counterpart" to U.S. Patent
21 No. 10,779,033. Sonos opposes, arguing that the statements it made in the Australian
22 prosecution do not justify revisiting settled claim construction positions (Dkt. No. 389). This
23 motion is suitable for resolution on the papers. Civ. L.R. 7-6.

24 The '033 patent is directed to transferring playback of a "remote playback queue" from a
25 "computing device" to a "playback device." In plain English, the patent relates to, for example,
26 transferring audio playback of a music playlist from a smart phone to a smart speaker. While
27 this case was in the Western District of Texas, Google sought to construe the term "remote
28 playback queue" as a "remote playback queue provided by a third party application." When

1 this case was transferred here, however, Google dropped the term from its disclosures and
2 abandoned its claim construction position.

3 Meanwhile, in September 2020, Sonos began prosecuting a similar patent application in
4 Australia. The Australian application shares the same title and virtually the same specification
5 and figures as the '033 patent. During prosecution, the Australian patent office found that the
6 term “remote playback queue” was not sufficiently disclosed. In response, Sonos’s counsel
7 made certain statements to the Australian patent office related to the scope of the term. Most
8 pertinently, Sonos counsel stated in June 2022 that the “‘remote playback queue’ referred to in
9 claim 1” of the Australian counterpart “corresponds to the queue that the user is
10 editing/managing in the third party application.” Sonos counsel then went on to state that the
11 “meaning of remote playback queue would clearly be the playback queue that the user is
12 managing in the third party application” (Exhs. 10–11).

13 These statements are problematic for Sonos because Google asserts that its accused
14 “remote playback queue” is not part of a third-party application. Thus, Google argues that these
15 statements qualify as “crucial admissions” and “new evidence” that justify revisiting claim
16 construction positions (Br. 11–12). Sonos responds, in part, that the bulk of any evidence that
17 would justify Google’s proposed construction was available to Google when the parties
18 exchanged claim construction briefing in March 2022. Sonos asserts that Google is using the
19 Australian statements as a ploy to reshuffle its claim construction strategy, and that our Patent
20 Local Rules were designed to eliminate such “gamesmanship” (Opp. 15–16).

21 Upon review, this order sides with Sonos. *First*, the Court of Appeals for the Federal
22 Circuit has “caution[ed] against indiscriminate reliance on the prosecution of corresponding
23 foreign applications in the claim construction analysis” because “the theories and laws of
24 patentability vary from country to country, as do examination practices.” *AIA Eng’g Ltd. v.*
25 *Magotteaux Int’l S/A*, 657 F.3d 1264, 1279 (Fed. Cir. 2011) (citation omitted). Here, Sonos has
26 cited material suggesting that correspondence between an applicant and the Australian patent
27 office may not be admissible for the purposes of claim construction under Australian law (Opp.
28 11). This in turn suggests that the statements may not have been “made in an official

1 proceeding in which the patentee had every incentive to exercise care in characterizing the
2 scope of its invention.” *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350 (Fed.
3 Cir. 2004). This order therefore proceeds cautiously.

4 *Second*, although the two patents are related and share a familial relationship, their claims
5 are not identical. In particular, claim 1 of the Australian application — the claim referred to in
6 the statements above — is not identical to claim 1 of the ’033 patent. Claim 1 of the ’033 patent
7 recites “a remote playback queue provided by a cloud-based computing system associated with
8 a cloud-based media service,” whereas claim 1 of the Australian application recites “a remote
9 playback queue provided by a computing system that is communicatively coupled to the zone
10 player via at least a cloud-based network” This casts doubt on the relevance of the
11 statements to the ’033 patent. *See, e.g., Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1313 (Fed.
12 Cir. 2014), *overruled on other grounds by Williamson v. Citrix Online, LLC*, 792 F.3d 1339
13 (Fed. Cir. 2015) (finding statement made during foreign prosecution persuasive in part because
14 the foreign application “contained a claim identical to” the claim at issue).

15 *Third*, when read in context, this order agrees with Sonos that the statements do not
16 qualify as the sort of “blatant admission” that warrants heightened scrutiny. *Cf. Gillette Co. v.*
17 *Energizer Holdings, Inc.*, 405 F.3d 1367, 1374 (Fed. Cir. 2005) (finding “blatant admission by
18 this same defendant before the [European Patent Office] clearly support[ed]” its claim
19 construction holding). The statements can be fairly read as a narrow argument proffering a
20 counterexample against the Australian patent office’s specific concerns over whether meaning
21 of the term “remote” could accommodate a “playback queue” located in a certain “geographic
22 location.” Put differently, Google’s assertion that the statements advocate for a universal and
23 limiting construction of “remote playback queue” is not convincing.

24 At bottom, this order finds that the statements carry too little weight to grant Google’s
25 request. Google wants to revise its claim construction position based on statements made by
26 foreign counsel in a foreign proceeding addressing a limited issue over a different claim. This
27 does not persuade. If Google did not consider the intrinsic evidence strong enough to weigh in
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1 its favor to advocate for its proposed construction earlier, the extrinsic statements here would
2 not have been afforded enough weight to move the needle. Google's motion is **DENIED**.

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4 **IT IS SO ORDERED.**

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6 Dated: December 21, 2022.

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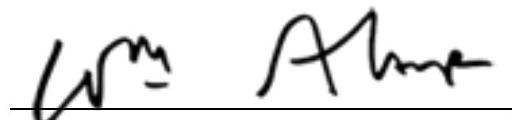
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WILLIAM ALSUP
UNITED STATES DISTRICT JUDGE